UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,318	01/30/2004	Anthony F. Scian	555255012534	7539 ·

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ART UNIT	PAPER NUMBER
2168	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

<table>
<tr><td rowspan="2" style="vertical-align:middle">Office Action Summary</td><td>Application No.</td><td colspan="2">Applicant(s)</td></tr>
<tr><td>10/768,318</td><td colspan="2">SCIAN ET AL.</td></tr>
<tr><td></td><td>Examiner</td><td>Art Unit</td><td></td></tr>
<tr><td></td><td>Cheyne D. Ly</td><td>2168</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 April 2007</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10,12-22, 24-28 and 32-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10,13-22,25-28 and 32-39</u> is/are rejected.

7)☒ Claim(s) <u>12 and 24</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☒ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. <u>6/29/07</u>.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Applicants' arguments filed April 24, 2007 have been fully considered but they are not

deemed to be persuasive. Rejections and/or objections not reiterated from previous office

actions are hereby withdrawn. The following rejections and/or objections are either reiterated or

newly applied. They constitute the complete set presently being applied to the instant

application.

2.   The cancellation of claims 11, 23, and 29-31, and addition of claims 32-39 have been

entered.

3.   Claims 1-10, 12-22, 24-28, and 32-39 are examined on the merits.

4.   NON-FINAL.

RESPONSE TO ARGUMENTS

5.   .   It is noted that Pancha et al. (US 6823373B1) (Pancha hereafter) taken with Goodhand et

al. (US 5923848A) (Goodhand hereafter) has been newly cited below to describe the claimed

invention as directed to the limitation of unspecified first event and second event.

CLAIM REJECTIONS - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if
> the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would
> have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   **Claims 1-10, 14-22, 25, 28, 32-37 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Pancha et al. (US 6823373B1) (Pancha hereafter) taken with Goodhand

et al. (US 5923848A) (Goodhand hereafter).

MOTIVATION TO COMBINE

9.   Pancha describes an improvement by providing "an open architecture delivers solutions

to for both mobile client application...to existing enterprise solutions such as Microsoft

Outlook...provides significant ease of use and productivity benefits to the mobile professional"

(column 3, lines 42-55). While, Goodhand describes the Microsoft Outlook program (column 8,

lines 38-40) that address the need for an e-mail system that simplifies the process of resolving

recipient addresses (column 4, lines 29-31). Therefore, one of ordinary skill in the art at the time

of the invention would have been motivated by Pancha to improve the Microsoft application that

simplifies the process of resolving recipient addresses to provides significant ease of use and

productivity benefits to the mobile professional as described by Goodhand.

PRIOR ART

10.   In regard to claim 1, Pancha discloses a mobile device...(column 4, line 56, to column

line 11, especially, "mobile devices"); and

Mobile device program code comprising program instructions executable by the

processing subsystem and stored in the memory subsystem and upon execution cause the

mobile device to:

Issue a query for contact data over a communication network (column 11, lines

36-38, especially, "a search is performed for a contact...");

Create a contact resolution object (Figure 9, block 29, especially,

"searchContacts(): Cusrsor" which is consistent with the exemplary disclosure of

"contact resolution object" by the instant specification (pages 17-19));

Receive contact data responsive to the query over the communication applications

(Figure 9, block 29, especially, "getContact(): Contact");

Associate the contact data received with the contact resolution object (Figure 9,

block 29, especially, the association of block 29 with block 30 "contact);

Reissue the query for contact data over the communication network (column 11,

lines 44-46, e.g. "a search...in a calendar application to retrieve events" and

Figure 17 where Event class comprises "owner:Contact") after the occurrence of

the first event (column 11, line 8, e.g. "receives an e-mail) and a second event

(column 11, lines 31-33, e.g. "data is extracted from MS Exchange to create a

new contact").

11.   However, Pancha does not describe the limitations of "resolve the contact resolution

object to select communication contact data" and "delete the contact data received after the

occurrence of a first event".

12.   Goodhand describes the limitation of resolve the contact resolution object to select communication contact data (column 17, line 22, to column 18, line 48, especially, "the e-mail program module begins to resolve the recipient names [contact]" and Figures 6a-c). Further, Goodhand describes the limitation of delete the contact data received after the occurrence of a first event (column 24, lines 18-25, e.g. "deleting...a message" the reception has been interpreted the required unspecified first event). Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft application that resolves the contact resolution object to select communication contact data to provides significant ease of use and productivity benefits to the mobile professional.

13.   In regard to claim 2, Pancha in view of Goodhand discloses the mobile device program code comprises further program instructions executable by the processing subsystem and stored in the memory subsystem and upon execution cause the mobile device to store the contact resolution object as a contact in an contact application (column 5, lines 37-50, especially, "synchronization with...PDAs (e.g. Palm, Windows CE devices)"). Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft application that resolves the contact resolution object to select communication contact data to provides significant ease of use and productivity benefits to the mobile professional.

14.   In regard to claim 3, Pancha in view of Goodhand discloses the selected communication contact data corresponds to a selected communication application (column 10, lines 12-56, especially, "data may be extracted from a MS Exchange...or a Lotus Nodes address book for the same contact"). Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft application that resolves the contact resolution object to select communication

contact data to provides significant ease of use and productivity benefits to the mobile professional.

15.   In regard to claim 4, Pancha in view of Goodhand discloses the contact resolution object is accessible as a contact by the one or more communication applications executed by the mobile device (column 5, lines 37-50, especially, "synchronization with...PDAs (e.g. Palm, Windows CE devices)"). Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft application that resolves the contact resolution object to select communication contact data to provides significant ease of use and productivity benefits to the mobile professional.

16.   In regard to claim 5, Pancha in view of Goodhand describes the contact resolution object is resolved in a communication application environment of a communication application (Goodhand, column 17, line 22, to column 18, line 48, especially, "the e-mail program module begins to resolve the recipient names [contact]" and Figures 6a-c). Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft application that resolves the contact resolution object to select communication contact data to provides significant ease of use and productivity benefits to the mobile professional.

17.   In regard to claim 6, Pancha in view of Goodhand discloses the query for contact data is issued from a communication application environment (column 11, lines 36-38, especially, "a search is performed for a contact..."). Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft application that resolves the contact resolution object to select communication contact data to provides significant ease of use and productivity benefits to the mobile professional.

18.   In regard to claim 7, Pancha in view of Goodhand describes the communication

application performs resolution independent functions that may be performed independent of

resolution of the contact resolution object (Goodhand, column 17, lines 12-14, especially, "form

and address field...are displayed on the monitor"), and performs resolution dependent functions

that may be performed after resolution of the contact resolution object (column 19, lines 7-9,

especially, "If none of the display names need to be resolved manually, the user...sends the e-

mail message"). Therefore, it would have been obvious to one of ordinary skill in the art to use

the Microsoft application that resolves the contact resolution object to select communication

contact data to provides significant ease of use and productivity benefits to the mobile

professional.

19.   In regard to claims 8 and 10, Pancha in view of Goodhand describes the contact data

responsive to the query...upon execution cause the mobile device to launch a communication

application corresponding to the selected communication contact data (column 10, lines 32-56,

especially, "[t]he mobile user could have just as easily, after the directory service, gone to a

calling service (make a phone call service instead to make a call to the contact's cell phone...").

Therefore, it would have been obvious to one of ordinary skill in the art to use the Microsoft

application that resolves the contact resolution object to select communication contact data to

provides significant ease of use and productivity benefits to the mobile professional.

20.   In regard to claim 9, Pancha in view of Goodhand describes the contact resolution object

is resolved in a contact application environment of the contact application (Goodhand, column

17, line 22, to column 18, line 48, especially, "the e-mail program module begins to resolve the

recipient names [contact]" and Figures 6a-c). Therefore, it would have been obvious to one of

ordinary skill in the art to use the Microsoft application that resolves the contact resolution object

to select communication contact data to provides significant ease of use and productivity benefits

to the mobile professional.

21.   In regard to claim 14, Pancha in view of Goodhand describes the program

instructions...cause the mobile device to auto-resolve the contact resolution object when the

contact data for only one contact is received (column 17, lines 38-41, "If a display name is

unambiguous and matches only one registered user, the name of that user is inserted in the

address field").

22.   In regard to claim 16, Pancha in view of Goodhad describes storing the contact resolution

object as a contract in a contact list (column 1, line 42, e.g. contact list).

23.   In regard to claims 15, 17-22, 25, 28, and 32-37, Pancha in view of Goodhand renders the

claims obvious over the cited prior art. For example, Pancha in view of Goodhand describes the

processor-implemented method (claim 1) of operating a mobile communications device as cited

above. Further, Pancha in view of Goodhand describes the mobile communication device

(Figure 2) as cited above. Therefore, it would have been obvious to one of ordinary skill in the

art to use the Microsoft application that resolves the contact resolution object to select

communication contact data to provides significant ease of use and productivity benefits to the

mobile professional.

24.   **Claims 13, 27, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Pancha et al. (US 6823373B1) (Pancha hereafter) taken with Goodhand et al. (US

5923848A) (Goodhand hereafter) in further view of Grossman et al. (US 20040119758A1)

(Grossman hereafter).

MOTIVATION TO COMBINE

25.   Pancha describes an improvement by providing "an open architecture delivers solutions

to for both mobile client application…to existing enterprise solutions such as Microsoft

Outlook…provides significant ease of use and productivity benefits to the mobile professional"

(column 3, lines 42-55). Goodhand describes the Microsoft Outlook program (column 8, lines

38-40) that address the need for an e-mail system that simplifies the process of resolving

recipient addresses (column 4, lines 29-31). While, Grossman describes a system for displaying

contact controls that can be used to quickly access contact information (page 1, [0011]).

Therefore, one of ordinary skill in the art at the time of the invention would have been motivated

by Pancha to improve the Microsoft application of Goodhand which simplifies the process of

resolving recipient addresses to provides significant ease of use and productivity benefits to the

mobile professional by quickly accessing contact information as described by Grossman.

PRIOR ART

26.   In regard to claims 13, 27, and 39, Pancha and Goodhand describe the limitations of said

claims except for the limitation of "the status indicia…" Grossman describes the limitation of

"the status indicia…" (page 1, [0005], especially, "Contact information can also refer to other

types of information such as the status of a contact"). Therefore, it would have been obvious to

one of ordinary skill in the art to used the method described by Pancha and Goodhand that

simplifies the process of resolving recipient addresses to provides significant ease of use and

productivity benefits to the mobile professional by quickly accessing contact information as described by Grossman.

27.   **Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pancha et al. (US 6823373B1) (Pancha hereafter) taken with Goodhand et al. (US 5923848A) (Goodhand hereafter) in further view of Ramakrishnan R. (1998).**

MOTIVATION TO COMBINE

28.   Pancha describes an improvement by providing "an open architecture delivers solutions tó for both mobile client application…to existing enterprise solutions such as Microsoft Outlook…provides significant ease of use and productivity benefits to the mobile professional" (column 3, lines 42-55). Goodhand describes the Microsoft Outlook program (column 8, lines 38-40) that address the need for an e-mail system that simplifies the process of resolving recipient addresses (column 4, lines 29-31) stored in a database (column 15, lines 47-48). While, Ramakrishnan describes the well known in the art lock management in databases (page 13). Therefore, one of ordinary skill in the art at the time of the invention would have been motivated by Pancha to improve the Microsoft application Goodhand that simplifies the process of resolving recipient addresses stored a database with the lock management of Ramakrishnan to protect the integrity of database objects.

PRIOR ART

29.   In regard to claims 26 and 38, Pancha and Goodhand describes the limitations to the claim except for the limitation of "precluding deletion of a contact resolution object…is referenced by a communication data." Ramakrishnan describes that it is well known in the art that the referencing of data provides an exclusive lock on said referenced data which would

preclude the deletion of said referenced data (page 13, lines 7-19). Therefore, it would have

been obvious to one of ordinary skill in the art to use the Microsoft application Goodhand that

simplifies the process of resolving recipient addresses stored a database with the lock

management as described by Pancha and Ramakrishnan.

CONCLUSION

30.   Claims 12 and 24 are objected to as being dependent upon a rejected base claim, but

would be allowable if rewritten in independent form including all of the limitations of the base
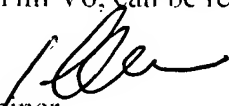
claim and any intervening claims.

31.   Patent applicants with problems or questions regarding electronic images that can be .

viewed in the Patent Application Information Retrieval system (PAIR) can now contact the

USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are

available to answer your questions daily from 6 am to midnight (EST). The toll free number is

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provides Internet-based access to patent application status and history information. It also

enables applicants to view the scanned images of their own application file folder(s) as well as

general patent information available to the public.

32.   For all other customer support, please call the USPTO Call Center (UCC) at 800-786-

9199. The USPTO's official fax number is 571-272-8300.

33.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The

examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

34.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly
Patent Examiner
7/5/07